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Christian Zander

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04/28/2009

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EXAMINER

SALOMON, PHENUEL S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/692,504 | Applicant(s) ZANDER, CHRISTIAN | |
| | Examiner PHENUEL S. SALOMON | Art Unit 2178 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Pre-Brief Appeal filed on 03/24/09. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Claims 1 and 11 are amended, and claims 1-11 are pending and have been considered below.

2. Claims 1, 3-7, 9-11 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Swift et al. (WO 98/57268) in view of Gessel et al. (US 5,732,213) have been withdrawn pursuant to applicant amendment.

3. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swift et al. (WO 98/57268) in view of Gessel et al. (US 5,732,213) and in further view of Matsui (US 6,560,723) have been withdrawn pursuant to applicant amendment.

Objection

4. The abstract of the disclosure is objected to because content is more than 150 words. Correction is required. See MPEP § 608.01(b).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d

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887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6, 7 and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2-3 and 5-7 of U.S. copending application No. 09/776040. The subject matter claimed in the instant application is fully disclosed in the U.S. copending application No. 09/776040 and would cover any patent granted on that U.S. copending application No. 09/776040, since the U.S. copending application No. 09/776040 and the instant application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two sets of claims is that the instant application include a variable where the other instance performs one of several activities as a function of the content of the variable that is not included in the independent claims 1 and 8 of the copending application No. 09/776040. In essence the instant application claims are narrower than the U.S. copending application No. 09/776040 claims. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a

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combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-7, 9-11 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Gessel et al. (US 5,732,213) in view of Swift (WO 98/57268).

Claim 1: Gessel discloses a method of setting up a procedure of a communication taking place between two instances, with one instance being a protocol tester and the other instance being a device under test, comprising the steps executable on the protocol tester of:

selecting the instances involved in the communication procedure (col. 3, lines 15-32);

selecting a protocol layer to be emulated on the basis of which the communication between the selected instances is to take place (col. 3, lines 42-58);

selecting abstract communication interfaces of the protocol layer which are involved in the communication (col. 10, lines 15-32);

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selecting communication data contained in description files to be exchanged at the abstract communication interfaces; (col. 3, lines 15-32).

within the communication data graphically (col. 11, line 55-col. 12, line 10);

with the selecting steps being performed graphically including a graphic configuration of a communication sequence between the instances involved (col. 11, lines 35-80); but does not explicitly disclose

defining a message from one instance to the other instance which contains a variable wherein the other instance performs one of several activities as a function of the content of the variable;

setting up a communication procedure executable between the instances through the protocol tester on the basis of the several selecting steps; but does not explicitly disclose

However Swift discloses:

defining a message from one instance to the other instance which contains a variable wherein the other instance performs one of several activities as a function of the content of the variable (page 18, paragraph 2) [target object 914 will perform the task based on the content of received data];

setting up a communication procedure executable between the instances through the protocol tester on the basis of the several selecting steps, (message created, interfaces produced with PowerBuilder/PowerSockets, specific description file in fig. 3, 222 (message sequence definition) (page 7, paragraph 3, lines 1-5, fig. 4A, items 406-422). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include Gessel's teaching in Swift. One would have been motivated to do so in order to eliminate the need for expensive test equipment and test tools for monitoring the communication links and performing protocol analyses or other evaluation tests.

Claim 3: Gessel and Swift disclose the method according to claims 1 or 2 above Gessel further discloses the step of specifying a loop functionality which the other instance executes as a function of the content of

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the variable (a simulated node 139 labeled "Loop" is positioned in the center of the display and is a holding point where the simulation waits for another message to be received) (col. 11, lines 10-15).

Claim 4: Gessel and Swift disclose the method according to claim 3 above, Gessel further discloses the loop functionality is selected from the group consisting of a for-next, a do-while and a while-do functionality (The process then moves to the loop node 139 and waits for the MSC emulator to respond to the request message. If the location updating request is accepted, the BSC simulation receives a location updating accept message at node 142) (col. 11, lines 30-35) [with the loop node 139 involved in the process, therefore these functionalities should be part of the process].

Claim 5: Gessel and Swift disclose the method 3 above, Gessel further discloses comprising the step of specifying a functionality selected from the group consisting of a jump/go-to functionality and an if-then functionality which the other instance executes as a function of the content of the variable (The process then moves to the loop node 139 and waits for the MSC emulator to respond to the request message. If the location updating request is accepted, the BSC simulation receives a location updating accept message at node 142) (col. 11, lines 30-35) [with the loop node 139 involved in the process, therefore these functionalities should be part of the process].

Claim 6: Gessel and Swift disclose the method according to claim 1 above, Swift further discloses the instances involved in the communication are graphically selected, the protocol layer is graphically selected, and the abstract communication interfaces are graphically selected (fig. 4a & 4b). One would have been motivated to do so in order to improve test data reliability.

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Claim 7: Gessel and Swift disclose the method according to claim 1 above Swift further discloses the abstract communication interfaces comprise SAPs (Service Access Points) (specific device) (fig. 4b, items 413 & 438). One would have been motivated to do so in order to improve test data reliability.

Claim 9: Gessel and Swift disclose the method according to claim 1 Gessel further discloses the communication data selecting step comprises the steps of:

d1) graphically selecting a data format; and d2) graphically setting up the communication sequence between the instances involved (col. 11, lines 35-80).

Claim 10: Gessel and Swift disclose the method according to claim 9 above Swift further discloses the communication sequence setting up step comprises the step of entering source code (customizing software/code for testing purposes) (page 2, paragraph 2, lines 1-7). One would have been motivated to do so in order to improve test data reliability.

Claim 11 is the means claim of claim 1 and is similarly rejected under the same rationale.

8. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessel et al. (US 5,732,213) in view of Swift (WO 98/57268) and in further view of Matsui (US 6,560,723).

Claim 2: Gessel and Swift disclose the method according to claim 1 above but does not explicitly disclose the step of specifying a switch functionality which the other instance executes as a function of the content of the variable. However, Matsui discloses test message function unit that perform transmission and reception based on information content (col. 7, lines 20-25). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time of the invention to include Matsui's teaching in Swift. One would have been motivated to do so in order to improve the reliability of test data.

Claim 8: Gessel and Swift disclose the method according to claim 1 above wherein the communication data but does not explicitly disclose comprise data selected from the group consisting of PDUs (Protocol Data Units) and ASPs (Abstract Service Primitives). However, Matsui discloses the communication data comprise at least one type selected from the group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives (ASP) (column 1, lines 55-column 2, lines 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include Matsui's teaching with method of Swift. One would have been motivated to do so in order to create a scenario for use in a conformation test.

Response to Arguments

9. Applicant's arguments filed on 2/20/2009 have been fully considered but are moot in view of new ground (s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Autrey et al. (US 5,774,695) discloses protocol interface gateway and method of connecting an emulator to a network.

b. Engel et al. (US 6,115,393) discloses network monitoring.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571) 270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00 P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272 4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS
04/25/2009

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit 2178